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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,818	01/28/2000	Mark Alperovich	109289.00121	2697
27557	7590	06/13/2005	EXAMINER	
BLANK ROME LLP 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037			ANGEBRANDT, MARTIN J	
			ART UNIT	PAPER NUMBER
			1756	
DATE MAILED: 06/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/493,818	Applicant(s) ALPEROVICH ET AL.	
	Examiner Martin J. Angebranndt	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/22/05 & 3/28/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The response provided by the applicant has been read and given careful consideration.

Responses to the arguments offered by the applicant are presented after the first rejection to which they are directed. The amendments to the specification are accepted.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al. '792.

Tamura et al. '792 teach optical recording media such as example 1-18 which mixes a **cyanine dye (201)** with a polymethine coloring agent coated on a polycarbonate substrate and dried. (1-1 is at column 28 and 1-18 is at column 31) The addition of other dyes, such as cyanine, phthalocyanine, xanthene dyes and stabilizers to the recording layer is disclosed. (25/15-26/26) The use of binders, including ethyl cellulose and nitrocellulose is disclosed. (26/61-65) The addition of plasticizers, surface active agents and the like to improve the film forming properties and stability of the coated film is disclosed. The examiner notes that the dispersants are surfactants (26/66-27/5) The use of various coating methods is disclosed. (27/12-23). The drying of the recording medium is disclosed in the examples. The use of underlayers between the support and the recording layer to protect the substrate from coating solvents and increase adhesion of the recording layer is disclosed. These may be 5-100 nm in thickness. The use of

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various resins is disclosed, including UV curing resins, thermosetting resins, vinyl resins, silicones, silica (silicon dioxide), liquid rubber (latexes) and thermoplastic resins. (27/30-53) Useful coating solvents are disclosed. (26-48) Useful substrates are also disclosed. (25/12-14). The formation of a air sandwich structure where two media are bonded together with an air gap or alternatively bonded directly to each other via a protective layers is disclosed. (27/66-28/7)

It would have been obvious to add a binder, a plasticizer and a stabilizer to the composition of example 1-18 of Tamura et al. '792 based upon the disclosure that these are desirable additives to the recording layer and to use a primer such as a thermosetting resin to increase the adhesion and the resistance of the substrate to damage from the coating solvents based upon the direction to do so. Additionally, it would have been obvious to form a dual recording layer media; using the air sandwich or bonded directly together via their protective layer to double recording capacity of a single medium.

The applicant argues intended use. The examiner notes that the claims are tot he article or methods of making it. The issue of how it is used is not relevant to the claims at hand unless it was impossible to use them in the manner described. This is clearly not the case. The rejection stands.

The applicant argues that polymethine dyes do not fluoresce, but misses the point as a cyanine dyes is also described in that reference in the cited example 1-18. Cyanine dyes are disclosed as fluorescent within the specification on page 5 at line 10. Cyanine dyes are actually a type of polymethine dyes, due to the presence of a polymethine linkage between the terminal groups, so the applicant's representative is also incorrect in the broad brush assertion that polymethine dyes are not fluorescent. The examiner notes that the dye on page 4 of JP 63-

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195838 is a polymethine dye and the abstract of the reference specifically describes the use of fluorescent dyes. The examiner notes that the claims are to the article, the coverage sought is for that article irrespective of use. The examiner adds that the assertion that the reference does not disclose fluorescent dyes is without merit based upon the disclosure in the instant specification on page 5 at line 10 and WO 99/243527. This is an inherent property, irrespective of if it is used with respect to the operation of the optical recording medium. The applicant neglects the fact that to fluoresce, light must be absorbed and therefore the use of transmittance or reflectance measurements at the laser wavelength, would be an acceptable means to determine the state of the cyanine dye. The emission does not affect the absorption of the light any differently than other relaxation means would. The absorption occurs first.

In response to the arguments of 01/21/2004, the examiner is aware of the requirements for formulating a rejection based upon obviousness. The examiner notes that the claims rejected under this heading are directed to the medium, irrespective of how it is used. The language "...at least one of the substrate, the fluorescent composition and the primer layer comprises a material providing effective adhesion ...so as to prevent formation on [sic, of] an interlayer boundary of non-fluorescent poly-molecular associates of fluorescent dyes causing quenching of fluorescence" means that the materials of the substrate, fluorescent layer or primer layer prevent di-, tri- or poly- mer dye aggregates/associates (see specification on page 4 at lines 4-7, which describes high molecular compounds, plasticizers and other ingredients as performing this function). Useful polymers, including cellulose, vinyl resins, acrylic resins and plasticizers are disclosed in page 5 at lines 12-20 of the instant specification. The applicant argues that no motivation is provided to modify the reference.

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The use of binders, including ethyl cellulose and nitrocellulose is disclosed (26/61-65) and the general addition of binders is disclosed as improving the film forming properties and stability of the coated recording film. The addition of plasticizers, surface active agents and the like to improve the film forming properties and stability of the coated film is disclosed. These modifications would seem to be desirable based upon these disclosures and therefore motivation is clearly present in the reference to add binders and plasticizers and the applicant has not shown any criticality in the materials beyond mentioning a few in the instant specification. The examiner notes that the dispersants are surfactants and are disclosed as having similar benefits (26/66-27/5). The claims merely require adhesion between the layers and specifically point to the materials contributing to the adhesion as being part of the primer, substrate or recording layer. The binders, and to a lesser degree any other additives, would be expected to prevent association of the dyes by dilution/occupying the intervening space between the dyes in the layer. This may be embraced by the "improving the film forming properties and stability of the film" discussed in the reference. Additionally, the use of underlayers between the support and the recording layer to protect the substrate from coating solvents and increase adhesion of the recording layer is disclosed (ie primer layers). **There may be a criticality to the materials providing the adhesion and preventing aggregation as argued by the applicant, but data supporting such an assertion is not in the record. The rejection stands.**

With respect to claims 21 and 22, the wavelength of the absorption is not recited and so the claims seek coverage for the embodiment where the transmittance is at any one wavelength and is not limited to this being the transmittance at the wavelength of the absorption maxima as discussed on page 15 of the specification.

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4. Claims 11,12,14,16 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. '495, in view of Tamura et al. '792 and Huh '588.

Inagaki et al. '495 teaches in example 7, the formation of a recording layer comprising a cyanine dyes together with a quencher. (19/35-20-29). The use of singlet oxygen quenchers to enhance the light fastness of the recording media is disclosed. (13/50-14/48). The use of binders is disclosed including cellulose derivatives, polyvinyl chloride and the like such that the dyes is present in the recording layer in an amount of 0.01-99 %, preferably 1-95%. The concentration of the dye in the coating solution is preferably 0.1-5% (14/42-15/21). The recording layer may be a single layer or a multilayer and the medium may have recording layers coated on both sides of the substrate or two substrate each bearing recording layers may be laminated together. (15/22-27, 16/23-36). The use of plasticizers and the like to the recording layer coating solution is disclosed. (14/61-63).

Tamura et al. '792 teach optical recording media such as example 1-18 which mixes a **cyanine dye (201)** with a polymethine coloring agent coated on a polycarbonate substrate and dried. (1-1 is at column 28 and 1-18 is at column 31). The dye content is 1 The addition of other dyes, such as cyanine, phthalocyanine, xanthene dyes and stabilizers to the recording layer is disclosed. (25/15-26/26) The use of binders, including ethyl cellulose and nitrocellulose is disclosed. (26/61-65) The addition of plasticizers, surface active agents and the like to improve the film forming properties and stability of the coated film is disclosed. The examiner notes that the dispersants are surfactants (26/66-27/5) The use of various coating methods is disclosed. (27/12-23). The drying of the recording medium is disclosed in the examples. The use of underlayers between the support and the recording layer to protect the substrate from coating

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solvents and increase adhesion of the recording layer is disclosed. These may be 5-100 nm in thickness. The use of various resins is disclosed, including UV curing resins, thermosetting resins, vinyl resins, silicones, silica (silicon dioxide), liquid rubber (latexes) and thermoplastic resins. (27/30-53) Useful coating solvents are disclosed. (26-48) Useful substrates are also disclosed. (25/12-14). The formation of a air sandwich structure where two media are bonded together with an air gap or alternatively bonded directly to each other via a protective layers is disclosed. (27/66-28/7).

Huh '588 teaches optical recording media where the dye/polymer concentration is 1-30% and is optimized based upon the sensitivity (too little and the laser power needs to be too high) and solubility (too much dye is not soluble in the solvent) (3/38-52). The use of cyanine dyes is disclosed. (3/38-51).

It would have been obvious to add a binder, a surfactant and a plasticizer to the embodiment of example 7 of Inagaki et al. '495, such that the cyanine dyes make up 1-10% of the resulting coated layer based upon the disclosure that binders are desirable additives to the recording layer within Inagaki et al. '495, Huh '588 and Tamura et al. '792, that plasticizers are desirable additives as taught by Inagaki et al. '495 and that plasticizers, and surface active agents are known to improve the stability and film forming properties of the recording layer as taught by Tamura et al. '792 and to use a primer such as a thermosetting resin to increase the adhesion and the resistance of the substrate to damage from the coating solvents based upon the direction to do so within Tamura et al. '792. Additionally, it would have been obvious to form a dual recording layer media, using the air sandwich, one recording layer coated on each side of the

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substrate or bonded directly together via their protective layer to double recording capacity of a single medium based upon the teachings of Inagaki et al. '495, in view of Tamura et al. '792

5. Claims 11-14, 16-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. '495, in view of Tamura et al. '792 and Huh '588, further in view of Sasakawa et al. '094.

Sasakawa et al. '094 teach the coating of optical recording media where the drying includes heating up to 100 degrees C. (8/1-3) Useful solvents are disclosed. (4/20-6/25). The use of polyvinyl chloride resins as substrate materials is disclosed. (3/7-12). The addition of soluble resins, such as ethyl cellulose, acrylic resins and various vinyl resins is disclosed. (7/1-11)

In addition to the basis provide above, the examiner holds that it would have been obvious to modify the process of over Inagaki et al. '495 combined with Tamura et al. '792 and Huh '588, by drying at 100 degrees C based upon the direction within Sasakawa et al. '094 that this is known in the art and produces useful optical recording media with a reasonable expectation of success.

6. Claims 11-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. '495, in view of Tamura et al. '792 and Huh '588, further in view of Sasakawa et al. '094 and Suzuki '574.

Suzuki '574 teaches cyanine dyes such as those disclosed in column 32 as useful in optical recording media. Useful solvents include diethylene glycol (38/42-43).

In addition to the basis provided above, it would have been obvious to use other solvents, such as diethylene glycol as taught by Suzuki '574, in the invention of Inagaki et al. '495,

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combined with Tamura et al. '792, Huh '588 and Sasakawa et al. '094 based upon the disclosure of equivalent function.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 11-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-26 of U.S. Patent No. 6,835,431 in view of Tamura et al. '792.

Alperovich et al. '431 claims fluorescent compositions containing fluorescent dyes, a polymer, a plasticizer, a solvent, a surfactant and a light stabilizer. (claim 2). The amount of dye is 0.001-0.1 mole/Kg or polymer (claim 3) and the dyes includes cyanine and oxazine dyes

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(claim 4). Claims 12-21 are directed to methods of making fluorescent optical recording media. Claims 22-26 claim the media themselves.

It would have been obvious to one skilled in the art to use the claimed composition in the method of making the articles claimed and/or the claimed optical recording mediumt, the amount of dye is 0.001-0.1 mole/Kg or polymer (claim 3), which overlaps the 0.1-10% of the instant claims of the instant application and further it would have been obvious to add an underlayer which acts as a primer layer to protect the substrate from coating solvents and increase adhesion of the recording layer as taught by Tamura et al. '792.

9. Claims 11-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim1-44 of U.S. Patent No. 6,682,799 in view of Tamura et al. '792.

Alperovich et al. '799 claims fluorescent optical recording media containing fluorescent dyes, a polymer and a plasticizer (claims 13 and 40). The amount of dye is 0.1-10% (claim 5) and the dyes includes cyanine and oxazine dyes (claim 2). The plasticizer may be in amounts of 10-50%. Claims 12-29 are directed to methods of making fluorescent optical recording media. Claims 1-20 and 30-44 claim the media themselves.

It would have been obvious to one skilled in the art to add a stabilizer and a surface active agent to the claimed compositions used in the media and in the methods based upon the disclosure that these are desirable additives to the recording layer and to use a primer such as a thermosetting resin to increase the adhesion and the resistance of the substrate to damage from the coating solvents based upon the direction to do so with Tamura et al. '792. Additionally, it

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would have been obvious to form a dual recording layer media, using the air sandwich or bonded directly together via their protective layer to double recording capacity of a single medium.

10. Claims 11-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-27 of U.S. Patent application No. 10/917384 (US prepub 2005/0013966) in view of Tamura et al. '792.

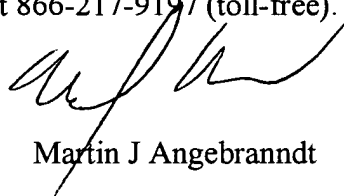
Alperovich et al. '966 claims fluorescent optical recording media containing fluorescent dyes, a polymer and a plasticizer (claims 13 and 40). The amount of dye is 0.1-10% (claim 10 and 22) and the dyes includes cyanine and oxazine dyes (claim 2). The plasticizer may be in amounts of 10-50% (13,25,27). Claims 15-20 are directed to methods of making fluorescent optical recording media. Claims 9-14 and 21-27 claim the media themselves.

It would have been obvious to one skilled in the art to add a stabilizer and a surface active agent to the claimed compositions used in the media and in the methods based upon the disclosure that these are desirable additives to the recording layer and to use a primer such as a thermosetting resin to increase the adhesion and the resistance of the substrate to damage from the coating solvents based upon the direction to do so with Tamura et al. '792. Additionally, it would have been obvious to form a dual recording layer media, using the air sandwich or bonded directly together via their protective layer to double recording capacity of a single medium.

8 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Martin J Angebranndt
Primary Examiner

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06/09/2005